

REMARKS

Claims 1-10, 13, and 14 are pending. Applicants have herein amended claims 1, 2, 5, 8-10, and 14 to delete embodiments wherein R³ is NHCOR¹⁰. Support for the amendments can be found throughout the specification, e.g., the compounds exemplified in the Examples and at paragraph [0045] of the U.S. Publication corresponding to the present application, U.S. 2005/0245741. No new matter has been added. Accordingly, claims 1-10, 13 and 14 are pending.

In light of the amendments and the remarks herein, Applicants respectfully request reconsideration and allowance of the pending claims.

Rejections under 35 U.S.C. § 103(a)

Claims 1-10, 13, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Pujol *et al.* (Eur. J. Med. Chem) ("Pujol"). The Examiner asserted that compounds 6a, 6f, and 6k, as disclosed in Pujol, are structural homologs of the claimed compounds, where the claimed compounds differ from the disclosed compounds based on the position of the substituent R³ on the phenyl ring. In addition, the Examiner asserted that Scheme 1 of Pujol disclosed a synthetic route for preparing the compounds 6a, 6f, and 6k, wherein the variable R (NHCOCH₃) could be present at any position of the phenyl ring.

Applicants respectfully disagree. The Federal Circuit has held that "in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish *prima facie* obviousness of a new claimed compound." (See *Takeda Chemical Industries, Ltd. v. Alphapharm Pty.*, 492 F.3d 1350, 83 U.S.P.Q.2d 1169 (Fed. Cir. 2007), emphasis added.) The disclosed Pujol compounds include a substituent in the 4 position of the phenyl ring, whereas the claimed compounds require a substituent in the 2-position of the phenyl ring. Contrary to the Examiner's assertion, given the context of the Pujol's reference, one having ordinary skill in the art would have understood Pujol's Scheme 1 to demonstrate synthesis of its particular 4-substituted compounds, rather than a general route to compounds having substituents at any ring

position. Moreover, and importantly, one having ordinary skill in the art would not have construed such a scheme to *particularly suggest* substituents in the 2 position, as claimed herein. Pujol itself states that compounds that have an acetamido substituent in the 4 position were best for adrenergic activity, supporting the position that Pujol not only does *not specifically* suggest moving its substituents from the 4 position to the 2 position (as in the claimed compounds), but also that Pujol in fact teaches away from such a 2 position. In sum, the law requires a more specific teaching or suggestion than that recited by the Examiner. Without such a teaching or suggestion in the art, a *prima facie* case cannot be maintained.

In order to expedite prosecution, however, and without prejudice to further prosecution in a continuing application, Applicants have herein amended the R³ moiety of the claims to remove the "NHCOR¹⁰" embodiments. Given such an amendment, Applicants respectfully assert that Pujol no longer renders the claim obvious, as Pujol does not disclose or suggest structural homologs of the presently claimed compounds. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

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CONCLUSION

Applicants respectfully submit that the present claims are in condition for allowance, which action is hereby requested. The Examiner is invited to telephone the under-signed attorney if such would expedite prosecution.

Please charge Deposit Account No. 06-1050 for the Request for Continued Examination fee and the Petition for Extension of Time fee (3 months). Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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